

REMARKS

The present Amendment is in response to the Official Action mailed July 9, 2008. Claims 1, 4, 6-11, 13, 32, 33, and 35-40 have been amended, claims 2, 3, 5, 12, 14-31, and 34 have either been canceled herein or previously canceled and, claims 41-44 are new. Therefore, claims 1, 4, 6-11, 13, 32, 33, and 35-44 remain currently pending in the present case. The following sets forth Applicant's remarks pertaining to the currently pending claims and the outstanding Action.

As an initial matter, Applicant wishes to thank the Examiner for taking the time on October 7, 2008 to briefly discuss the outstanding Action with Applicant's undersigned counsel. Applicant also thanks the Examiner for indicating, in both that discussion and the Action, that he would permit amendments of the claims that shift election of inventions from the sub-combination drawn to an orthopedic trial augment to a combination which positively recites as elements the augment and the femoral trial implant. Applicant has made such amendments of the currently pending claims above, such that each and everyone of the currently pending claims are now directed to "an assembly." In the aforementioned telephone discussion, the Examiner explained that because none of the prior art references teach an orthopedic trial augment similar to the one of the present invention in connection with a femoral trial implant, claims directed to such an assembly would be allowable. Again, Applicant thanks the Examiner for this indication. A brief discussion of the above-made amendments and the cited prior art is nonetheless set forth below.

As both currently pending independent claims 1 and 32 are now directed to an assembly including a femoral trial implant and an orthopedic trial augment, with different limitations of each component also set forth in those claims, Applicant respectfully submits that such claims constitute

allowable subject matter. Specifically, none of the prior art cited in the outstanding Action (or any prior art cited to date) teaches such a construction. In particular, U.S. Patent Application Publication No. 2004/0019353 to Freid et al. ("Freid") and WO 01/89428 to Sevrain et al. ("Sevrain") are both directed to devices for implantation in the spine. Because the currently pending claims have been amended to recite both the femoral trial implant and the previously claimed orthopedic trial augment, those references can no longer be applied to the claims. Furthermore, the only other reference cited in the outstanding Action, U.S. Patent No. 5,571,194 to Gabriel ("Gabriel"), simply does not teach an expandable augment that meets the limitations set forth in independent claims 1 and 32. Thus, Applicant respectfully submits that none of Freid, Sevrain, and/or Gabriel should be utilized in rejecting the presently pending claims. In the October 7th telephone discussion, the Examiner agreed with these contentions.

Moreover, Applicant notes that certain of the claims have been amended in response to the rejections under 35 U.S.C. § 112 set forth in the Action. In particular, the misspelling and the inadvertent second occurrence of the word "that" pointed out by the Examiner have been corrected in claim 1, and the issue regarding claim 14 is mooted given the cancellation of that claim. Applicant respectfully submits that the § 112 rejections have thusly been overcome.

Therefore, Applicant respectfully requests allowance of each and every one of the currently pending claims. Although only independent claims 1 and 32 have been specifically discussed above, Applicants note that their dependent claims are also allowable based upon their proper dependence from claim 1, claim 32, or an intervening claim. The presently pending dependent claims have been amended to refer to the assembly set forth in either independent claim 1 or independent claim 32 (or

an intervening claim), so such claims are in proper antecedent form. Furthermore, such claims may in and of themselves include subject matter allowable over the prior art. Applicant reserves the right to argue any of such claims (if necessary) at a later date. Thus, in view of all of the above, Applicant respectfully requests allowance of each and every one of the currently pending claims.

Finally, Applicant notes that in the aforementioned October 7th discussion with the Examiner, the Examiner indicated that should any further rejections and/or objections be necessary, he would consider contacting Applicant's undersigned counsel in lieu of issuing another formal written opinion. In such an event, Applicant respectfully requests that the Examiner do so.

As it is believed that all of the rejections set forth in the Official Action have been fully met, favorable reconsideration and allowance are earnestly solicited. If, however, for any reason the Examiner does not believe that such action can be taken at this time, it is respectfully requested that he telephone Applicant's attorney at (908) 654-5000 in order to overcome any additional objections which he might have. If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

Dated: October 9, 2008

Respectfully submitted,

By 

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